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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,870	04/06/2001	John F. Acres	4164-168	6066

7590 01/29/2003

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EXAMINER

HARRISON, JESSICA

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

**Office Action Summary**Application No.  
**09/827,870**

Applicant(s)

Acres et al.

Examiner

J. Harrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Nov 12, 2002
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19, 20, 62-67, and 77-98 is/are pending in the application.
- 4a) Of the above, claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 88-98 is/are allowed.
- 6) ☒ Claim(s) 62-67 and 77-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 19 and 20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                                                 |                                                                             |
|-----------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>2,3,7</u> | 6) <input type="checkbox"/> Other:                                          |

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## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election without traverse of Group II in Paper No. 8 is acknowledged. Claims 19 and 20 are withdrawn from consideration. Claims 68 - 76 of elected group II have been canceled. Claims 88-98 have been added.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 77, 78 and 79 at least are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6 and 7 of U.S. Patent No. 5,655,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences comprise minor semantical differences, rephrasings, and omissions of non-critical subject matter. For example, the instant claims deletes "over the network" from the monitoring step, and adds that the payout table is stored in the device. Patent step activating is rephrases as initiating in the instant claim.

Claims 62-64, 66 and 67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24-26, 28 and 29 of U.S. Patent No. 5,836,817. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is a minor rephrasing. In the application, the "initiating a bonus period" step has been deleted and incorporated into the transmitting step with "transmitting...only if a bonus period has been initiated". The remaining claims are identical.

### *Interference*

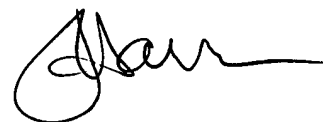
It is noted that applicant has copied claims from US Patent 5,885,158 for the purpose of provoking an interference. The copied claims are newly added claims 88-98. Applicant has submitted a proposed count, defined the claims corresponding to the proposed count, applied the

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terms of the proposed count to the disclosure of the application, and satisfied the requirements of 35 USC 135(b), 37 CFR 1.607(b) and 37 CFR 1.608(a). It appears as though claims 88-98 are patentable to applicant. Pending resolution of the above outstanding rejection, an interference will be declared.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Harrison whose telephone number is (703) 308-2217.

A handwritten signature in black ink, appearing to read 'J. Harrison', with a stylized, flowing script.

JESSICA HARRISON  
PRIMARY EXAMINER

jjh